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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,781	03/30/2005	Christian Wulff	268898US0PCT	1489
22850 7590 01/03/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER SOLOLA, TAOFIQ A	
			ART UNIT 1625	PAPER NUMBER
			NOTIFICATION DATE 01/03/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/529,781

Applicant(s)

WULFF ET AL.

Examiner

Taofiq A. Solola

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 21 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-19 and 23-32 is/are pending in the application.
- 4a) Of the above claim(s) 4-19 and 24-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3, 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claims 1-19, 23-32 are pending in this application.

Claims 20-22 are cancelled.

Claims 1-2 (in part), 4-19, 24-32 are drawn to non-elected invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 3, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horibe et al., JP 2001/300286, and Okutsu et al., JP 2001/114719, individually, in view of Rubinfeld et al., US 3,320,174, Durbut et al., WO 97/04059, (Durbut I) Durbut et al., WO 98/00418 (Durbut II) and Potthoff-Karl et al., US 5,994,290, individually.

Applicant claims compounds of formula (I) wherein A and B together form 1,3-furandione ring and composition thereof. In preferred embodiments, Applicant claims the compositions having different percentages of the compounds, and at least another active ingredient.

Determination of the scope and content of the prior art (MPEP 2141.01)

Horibe et al., teach similar compounds and methods of using them as surfactants. See the marked compounds in the abstracts.

Okutsu et al., teach similar compounds and methods of using them as surfactants. See the marked compounds in the abstracts.

Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

The difference between the instant invention and that of Horibe et al., and Okutsu et al., is that the alkyl chain in the compounds of Applicant is longer than in the prior arts. Also, applicant claims different percent compositions of the compounds and a composition comprising additional active surfactant. In other words, applicant replaced H with alkyl in the compounds of the prior arts.

Finding of prima facie obviousness—rational and motivation (MPEP 2142.2413)

However, Rubinfield et al., (col. 3-8, particularly tables III and IV), Durbut I and II (pages 21-22 and 6-24 respectively) and Potthoff-Karl et al., (col. 12-14, tables 1-2) teach various percent compositions of surfactant/detergent compounds. Also, H and alkyl are art recognized equivalents. *In re Lincoln*, 126 USPQ 477, 53 USPQ 40 (CCPA, 1942); *In re Druey*, 319 F.2d 237, 138 USPQ 39 (CCPA, 1963); *In re Lohr*, 317 F.2d 388, 137 USPQ 548 (CCPA, 1963); *In re Hoehsema*, 399 F.2d 269, 158 USPQ 598 (CCPA, 1968); *In re Wood*, 582 F.2d 638, 199 USPQ 137 (CCPA, 1978); *In re Hoke*, 560 F.2d 436, 195 USPQ 148 (CCPA, 1977); *Ex parte Fauque*, 121 USPQ 425 (POBA, 1954); *Ex parte Henkel*, 130 USPQ 474, (POBA, 1960).

When the difference between compounds is the length of a carbon chain such are adjacent homologs. However, adjacent homologs are prima facie obvious. *In re Henze*, 85 USPQ 261 (1950). For the compounds of the prior art to be used as surfactants they must be used in form of compositions. Therefore, the instant invention is prima facie obvious from the teachings of the prior arts. One of ordinary skill in the art would have known to claim various percent compositions of the compounds and replace H with alkyl at the time the invention was made. The motivation is from knowing that surfactants/cosurfactants are used in various percent compositions of the compounds as taught in the prior arts, from knowing that H and alkyl are equivalents and that adjacent homologs would have similar biochemical properties.

Priority Claim

The instant application claims priority to a foreign document. However, a certified English translation copy of the document has not been filed. Therefore, the priority is denied. However, the denial would be revisited when the copy is filed. Also, English translation of the International Search Report has not been filed.

Response to Argument

Applicant's arguments filed 11/21/07 have been fully considered but they are not persuasive. Applicant contends that the instant compounds have branched alkyl instead of straight chain alkyl by the prior arts. This is not persuasive because applicant ignores the holding in *In re Wood*, and similar cases, *supra*. Applicant also argues the instant compounds and that of the prior arts have different utilities. This is not persuasive because surfactant and cosurfactant are deemed surfactants. Also, intended use is not a limitation of a compound or product. *In re Hack*, 114USPQ 161 (CCPA, 1957); *In re Craig*, 90 USPQ 33 (CCPA, 1951); *In re Brenner*, 82 USPQ 49 (CCPA, 1949). Even then, something old or obvious does not become new upon discovery of new properties, functions or utilities, *In re Best*, 562 F.2d 1252; 195 USPQ 430 (CCPA, 1977).

Applicant further contends that none of the prior arts discloses or suggests branching of the alkyl chain. This argument is foreclosed by the recent decision in *KSR Int. Co. v. Teleflex Inc.*, 550 U.S. ----, 82 USPQ2d 1385 (2007).

On the issue of filing English translation of a foreign priority document, 119(a)(4)(i)(A), states it may be filed when needed to resolve interference, while 119(a)(4)(i)(C), states "when specifically required by the examiner."

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

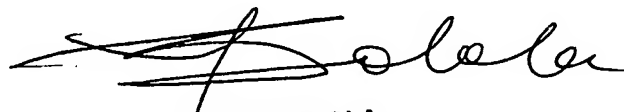
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.



**TAOFIQ SOLOLA
PRIMARY EXAMINER**

Group 1626

December 18, 2007